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09/591,009	06/09/2000	Ashok K. Shukla		3502

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Ashok K. Shulka  
10316 Kingsway Court  
Ellicott City, MD 21042

EXAMINER

THERKORN, ERNEST G

ART UNIT	PAPER NUMBER
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1723

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Paper No. 28

Application Number: 09/591,009

Filing Date: June 9, 2000

Appellants: Ashok Shukla, Mukta Shukla, and Amita Shukla

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Ashok K. Shukla

For Appellants

**EXAMINER'S ANSWER**

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This is in response to the appeal brief filed December 23, 2002 and the supplemental brief of March 21, 2003.

**(1) *Real Party in Interest***

A statement identifying the real party in interest is contained in the brief of December 23, 2002.

**(2) *Related Appeals and Interferences***

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief of December 23, 2002.

**(3) *Status of Claims***

The statement of the status of the claims contained in the brief of December 23, 2002 is correct.

**(4) *Status of Amendments After Final***

The appellants' statement of the status of amendments after final rejection contained in the supplemental brief of March 21, 2003 is correct. The amendment after final rejection dated September 18, 2002 was not entered.

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**(5) *Summary of Invention***

The summary of invention contained in the brief of December 23, 2002 is correct.

**(6) *Issues***

The appellants' statement of the issues in the supplemental brief of March 21, 2003 is substantially correct. The changes are as follows: Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Valaskovic (U.S. Patent No. 6,190,559) in view of Sanford (U.S. Patent No. 5,589,063).

**(7) *Grouping of Claims***

The rejection of claims 1, 2, 4, 5, 7-11, 13-16, and 20 stand or fall together because appellants' brief of December 23, 2002 includes a statement that this grouping of claims stands or falls with claim 1. See 37 CFR 1.192(c)(7).

**(8) *Claims Appealed***

The copy of the appealed claims contained in the Appendix to the supplement brief of March 21, 2003 is correct. The claims in the brief of December 23, 2002 contain substantial errors as presented in the Appendix to the brief. The claims in the brief of December 23, 2002 are directed to the unentered amendment of September 18, 2002.

**(9) *Prior Art of Record***

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

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6,190,559	Valaskovic	February 20, 2001
5,589,063	Sanford	December 31, 1996
4,341,635	Golias	July 27, 1982

**(10) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1, 2, 4, 5, 7-11, 13-16, and 20 stand rejected under 35 U.S.C. 102(E) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Valaskovic (U.S. Patent No. 6,190,559). The claims are considered to read on Valaskovic (U.S. Patent No. 6,190,559). However, if a difference exists between the claims and Valaskovic (U.S. Patent No. 6,190,559), it would reside in optimizing the elements of Valaskovic (U.S. Patent No. 6,190,559). It would have been obvious to optimize the elements of Valaskovic (U.S. Patent No. 6,190,559) to enhance separation.

Claim 4 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Valaskovic (U.S. Patent No. 6,190,559) in view of Sanford (U.S. Patent No. 5,589,063). At best, the claim differs from Valaskovic (U.S. Patent No. 6,190,559) in reciting use of multiple units. Sanford (U.S. Patent No. 5,589,063) (column 2, lines 11-18) discloses that use of an array of columns allows automated processing without technician intervention. It would have been obvious to use an array of columns in Valaskovic (U.S. Patent No. 6,190,559) because Sanford (U.S. Patent No. 5,589,063) (column 2, lines 11-18) discloses that use of an array of columns allows automated processing without technician intervention.

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Claim 20 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Valaskovic (U.S. Patent No. 6,190,559) in view of Golias (U.S. Patent No. 4,341,635). At best, the claim differs from Valaskovic (U.S. Patent No. 6,190,559) in reciting use of a piston. Golias (U.S. Patent No. 4,341,635) (column 3, lines 20-26) discloses that use of a plunger forms a pressure drop across the particles. It would have been obvious to use a plunger in Valaskovic (U.S. Patent No. 6,190,559) because Golias (U.S. Patent No. 4,341,635) (column 3, lines 20-26) discloses that use of a plunger forms a pressure drop across the particles.

**(11) *Response to Argument***

Appellants urge patentability based upon the allegation that claim 1 is not anticipated by Valaskovic (U.S. Patent No. 6,190,559). However, claim 1 reads on Valaskovic (U.S. Patent No. 6,190,559). The claimed limitations are set forth below. Claim 1's limitation of a pipette tip is disclosed in Valaskovic (U.S. Patent No. 6,190,559) on column 4, line 57; column 7, line 36; and column 8, line 24. Valaskovic (U.S. Patent No. 6,190,559)'s particles are chromatographic as disclosed in Valaskovic (U.S. Patent No. 6,190,559) on column 1, lines 15-17 and column 4, line 1. In addition, a comparison of appealed claim 15 and column 2, lines 55, 56, and 61 of Valaskovic (U.S. Patent No. 6,190,559) reveals both the appealed claims and Valaskovic (U.S. Patent No. 6,190,559) are directed to the same particles, namely, silica and polystyrene. An inspection of Valaskovic (U.S. Patent No. 6,190,559)'s Figures 1, 2, 3, 4, and 8 reveals claim 1's

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open upper end and closed lower end with one perforation to permit the passage of fluids. The packing particles are retained as recited by claim 1 either by Valaskovic (U.S. Patent No. 6,190,559)'s column 2, lines 4-7's sintering or by column 6, lines 24-25 and 64-67 tight packing. As such, all the limitations of claim 1 are disclosed in Valaskovic (U.S. Patent No. 6,190,559).

Appellants appear to urge patentability based upon the allegation that claim 1 is limited to a slit. However, an inspection of claim 1 reveals that claim 1 is directed to a perforation. Claim 10 indicates perforation reads on a hole as pictorially shown in Valaskovic (U.S. Patent No. 6,190,559) in Figures 1, 2, 3, 4, and 8.

Appellants appear to urge patentability based upon the allegation that the particles are larger than the perforations. However, claim 1 does not recite that the particles are larger than the perforation. Claim 1 recites that the particles are retained by the pipette tip. The packing particles are retained as recited by claim 1 either by Valaskovic (U.S. Patent No. 6,190,559)'s column 2, lines 4-7's sintering or by column 6, lines 24-25 and 64-67 tight packing. As such, all the limitations of claim 1 are disclosed in Valaskovic (U.S. Patent No. 6,190,559).

Appellants appear to urge patentability based upon the allegation that Valaskovic (U.S. Patent No. 6,190,559) uses capillary action to fill the tube and that the claimed device is loaded from the open end. However, no such limitation can be found in the claims. In any event, the claims are directed to product claims which would not reflect method of making limitations.

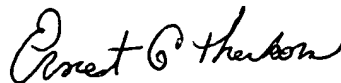
Appellants appear to urge patentability based upon the allegation that Valaskovic (U.S. Patent No. 6,190,559) requires sintering. Excluding sintering can not be found in the claims.

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However, on column 2, line 7, Valaskovic (U.S. Patent No. 6,190,559) indicates that sintering is only optional. One explanation why sintering is not required appears on column 6, lines 23-24 of Valaskovic (U.S. Patent No. 6,190,559). During evaporation the meniscus packs the slurry into a tight slug of material. On column 6, lines 64-67, Valaskovic (U.S. Patent No. 6,190,559) discloses vibration and/or slow rotation during evaporation promotes enhanced packing density. Accordingly, excluding sintering is not claimed and Valaskovic (U.S. Patent No. 6,190,559) does not require sintering.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



**Ernest G. Therkorn**  
**Primary Examiner**  
**Art Unit 1723**

EGT/12  
April 22, 2003

Conferees:

Wanda L. Walker  
SPE Art Units 1722/1723



Douglas McGinty  
Quality Assurance Specialist





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